

**BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Gilbert et al.
Application No. : 09/982,709 Confirmation No. : 8648
Filed : October 18, 2001
For : SYSTEMS AND METHODS FOR QUOTING A TWO-
SIDED MARKET
Group Art Unit : 3621
Examiner : Winter, John M

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Sir:

This is a Reply to the Examiner's Answer dated August 19, 2008. Applicants address herein all of the new grounds of rejection. Accordingly, Applicants request that the appeal be maintained.

The Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-3938.

I. STATUS OF CLAIMS

The following claims are pending and stand rejected in the present application:

- Independent claims **1, 14, 30, and 43.**
- Dependent claims **2, 4-5, 10-13, 17-18, 23, 25, 31, 33-34, 39-42, 46-47, 52, 54, and 106-117.**

The following claims are being appealed:

- Independent claims **1, 14, 30, and 43.**
- Dependent claims **2, 4-5, 10-13, 17-18, 23, 25, 31, 33-34, 39-42, 46-47, 52, 54, and 106-117.**

The following claims have been cancelled:

- Dependent claims **3, 6-9, 15-16, 19-22, 24, 32, 35-38, 44-45, 48-51, 53, and 55-105.**

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection to be reviewed on appeal are whether:

- Claims **1, 109, and 115¹** are indefinite under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention.
- Claims **1-2, 3-5, 10-14, 17-18, 23, 25, 30-31, 33-34, 39-43, 46-47, 52, 54, and 106-117²** are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,809,403 (hereinafter “Broka”) in view of U.S. Patent No. 5,375,055 (hereinafter “Tougher”).
- **(NEW GROUNDS)** Claims **1-2, 3-5, 10-14, 17-18, 23, 25, 30-31, 33-34, 39-43, 46-47, 52, 54, and 106-117** are directed to non-statutory subject matter under 35 U.S.C. § 101.

¹ In the Examiner’s Answer, claim 4 is no longer being rejected under 35 U.S.C. § 112.

² This Examiner now rejects claim 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-107. Although somewhat better than the previous Examiner, this Examiner still missed that claims 3, 24, 32, and 44-45 have been cancelled.

III. ARGUMENT

Note, this Reply only addresses the New Grounds for rejection in the Examiner's Answer and addresses the Examiner's response to our arguments. Applicants request that the Board consider the arguments presented in our Appeal Brief along with those presented herein.

Rejection under 35 U.S.C. § 112

Claims 1, 30, 109, and 115

The Examiner's response is a repeat of the rejection. Applicants refer the Board to the reasons set forth in the Appeal Brief, pages 5-6

Claims 4, 17, 33, and 46

The Examiner has not repeated the rejection nor responded to our arguments. The Examiner therefore concedes that claims **4, 17, 33, and 46**, and claims **106-110** and **112-116** that depend on either claim **4** or **33** are not indefinite under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 103(a)

Note, with regard to the rejections under 35 U.S.C. § 103, the Examiner's Answer is an exact copy of the May 14, 2007 Office Action, including all of its flaws.³

1. Claims 1, 14, 30, and 43.

a) At page 10 of the Examiner's Answer, "The Examiner stated that trading based on spreads are old and well known", referring to the Nov. 30, 2005 Office Action at page

³ In the early office actions, Examiner Calvin Hewitt III rejected the then pending claims without any great specificity. Examiner Hewitt further recycled those rejections in subsequent office actions without addressing any terms added to the claims by amendment.

7. The Examiner further stated “the Appellant did not seasonably challenge (Office Action of Feb. 23, 2007) the Examiner’s assertion, therefore, the Examiner regards such a teaching as an admitted prior art.”

The Examiner’s unsupported assertion of what is well known in the art as a basis of forming an obvious type rejection is inappropriate under the substantial evidence standard of review. In a determination of obviousness, factual findings as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed invention and the prior art, and secondary considerations of nonobviousness must be supported by substantial evidence. *Novamedix Distrib. Ltd. v. Dickinson*, 175 F. Supp. 2d 8, 9 (D.D.C. 2001). General conclusions about what it believed to be “basic knowledge and common sense [in the art] that is not based on any evidence in the record lacks substantial evidence support.” *In re Zurko*, 258 F.3d 1379, 1385 (Fed Cir. 2001). “The [Examiner] cannot reach conclusions based upon his own assessment, understanding, or experience of what it considers to be basic knowledge or common sense”, instead, “the [Examiner] must point to some concrete evidence in the record in support of these findings.” *Id.* at 1386. *See* MPEP § 2144.03 (C). Absent such evidence, an Examiner relying unsupported assertions of what is well known necessarily fails to establish a prima facie case.

b) The Examiner further asserts that Laborde (US Patent No. 4,588,192) discloses spreads for determining positions profitable in transactions. Applicants disagree.

The Examiner is interpreting the term “a pre-set spread amount” without any regard to the rest of the terms of the claims. Applicants are not merely claiming a “a pre-set spread amount”. The claims clearly recite “generating automatically at least one of a price and a size for an offer to sell the item based on at least one of a price and a size for a bid to buy the item and a pre-set spread amount.” Laborde fails to disclose or otherwise suggest this feature.

c) With regard to the presentation aspect of claims 14 and 43, the Examiner’s response is a repeat of the rejection. Applicants refer the Board to the reasons set forth in the Appeal Brief, pages 8-9. Applicants further direct the Examiner to *In re Wilson*, 424 F.2d 1382,

1385 (CCPA 1970), which held that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”

d) With regard to the presentation of the second interface screen aspect of claims 14 and 43, the Examiner asserts at page 13 of the Examiner’s Answer that the “Appellant’s arguments are moot in that the limitations disclosed are not actually present in the invention claimed, i.e. the bid command is received with i.e., in response to, a user selecting a piece of the bid and offer data displayed in the first interface screen.” The Examiner further states that there is no limitation involving the selection of data. The Examiner is mistaken.

Claims 14 and 13 clearly recite “presenting a second interface screen comprising at least one field for specifying at least one term for the bid to buy the item **populated with the selected piece of the bid and offer data**”. As the interface screen is being populated with the selected data, there necessarily must be a selection.

Rejection under 35 U.S.C. § 101

Claims 1, 30, 109, and 115

The Examiner rejects claims **1-2, 3-5, 10-14, 17-18, 23, 25, 30-31, 33-34, 39-43, 46-47, 52, 54, and 106-117** are directed to non-statutory subject matter under 35 U.S.C. § 101.

The Examiner ignores controlling Federal Circuit precedent that applies “a useful, concrete and tangible result” test to process type claims. *State Street Bank & Trust Company v. Signature Financial Group, Inc.*, 49 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). Applicants submit that all of the pending claims satisfy this test. Moreover, claims **14, 17-18, 23, 25, 43, 46-47, 52, 54, 106-110, and 112-116** and recite displaying and presenting first and/or second interface screens that are automatically populated with certain types of data. This necessarily involves a display associated with a computing device. As such, this is not merely a nominal recitation of technology.

IX. CONCLUSION

In view of the foregoing, Appellants submit that independent claims **1, 14, 30, and 43** are in proper condition for allowance, and the Board is respectfully requested to overturn the Examiner's rejection of these claims.

Respectfully submitted,

/Antonio Papageorgiou/

October 20, 2008

Date

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